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REMARKS

Claims 59-61 and 63-65 were examined and rejected. Claims 1-58 are cancelled and claims 62 and 66-86 are withdrawn.

Claim 87 is amended. Regions of inteins are discussed on page 30 line 17- page 32 line 4; page 9 lines 19-25, and page 10 lines 26-31. The term "region" is found in page 30, line 30. Support for a fusion protein is capable of undergoing a cyclization reaction to produce a cyclic peptide is found at, for example, page 28, lines 11-14; page 30, lines 21-24; and page 31, lines 38-41. Figs. 1A and 2B illustrate a fusion protein undergoing a cyclization reaction to produce a cyclic peptide in detail. Accordingly, no new matter is added.

Claim 91 is cancelled.

Applicants respectfully request reconsideration in view of the remarks set forth below.

Interview Summary

The Applicants wish to express their gratitude to Examiner Wessendorf for the telephonic interview on April 8, 2005, with Applicants' representative James Diehl, Carol Francis and James Keddie.

The Applicants wish to express their gratitude to Examiner Wessendorf for subsequent telephonic interviews in June, 2005, with Applicants' representative James Keddie.

Current rejections were discussed, as well as arguments to overcome those rejections.

Examiner Wessendorf commented that claims directed to vectors encoding an intein from *Synechocystis* would likely be allowable.

Claims 87-90 and 92-94 recite a *Synechocystis* intein.

In view of Examiner Wessendorf's comments, an allowance of claims 87-90 and 92-94 is respectfully requested.

Support for the claimed retroviral vector

During the aforementioned interview, Examiner Wessendorf requested that the Applicants point out specific support for the claim-recited retroviral vector.

The Applicants respectfully point out that an example of what is being claimed is illustrated at

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the top of page 15A. Further, support for a mammalian cell is found on page 29, line 25, retroviral vectors are discussed in great detail on page 24, and support for a retroviral vector encoding a intein fusion protein is found in claim 11 as originally filed.

For the convenience of the Examiner, the Applicants prior arguments, as set forth in the response dated January 5, 2005, are reiterated in their entirety.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 59-61 and 63-65 are rejected for failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. The Applicants respectfully traverse this rejection.

Without wishing to acquiesce to this rejection and solely to expedite prosecution, claim 59 has been amended to recite a intein of *bacterial or yeast* origin. Further, claim 59 has been amended to require that the fusion protein is capable of producing a cyclic peptide in a *mammalian* cell.

Pursuant to the afore-mentioned interview and since such a system is exactly what the Applicants describe in their examples, it is believed that this rejection has been adequately addressed.

The Examiner is respectfully requested to consider the amendments to claim 59, and withdraw this rejection in view of those amendments.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 59-61 and 63-65 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office asserts that it is not clear if the peptide of interest is different from the cyclic peptide.

Without any intention to acquiesce to the correctness of this rejection and solely to expedite prosecution, claim 59 has been reworded for clarity.

The Applicants respectfully submit that this rejection has been adequately addressed and may be withdrawn.

The Examiner is respectfully requested to kindly suggest language that would be found more suitable if the amendments to claim 59 do not overcome this rejection.

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Rejections under 35 U.S.C. § 103

Claims 59-61 and 63-65 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Scott or Evans in view of a patent by Nolan.

The Applicants submit that the subject matter of the cited Nolan patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Rigel. Accordingly, Nolan cannot preclude the patentability of the rejected claims, and this rejection may be withdrawn.

Support for this assertion is set forth below:

35 U.S.C. 103 (a) states that a patent may not be obtained if the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made¹. 35 U.S.C. 103 (c), however, states that subject matter developed by another person shall not preclude patentability under 103(a) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.²

According to 35 USC § 103(c), therefore, the Nolan patent cannot preclude the patentability of the rejected claims if the Nolan patent and the instant application were assigned to the same person or subject to an obligation of assignment to the same person, at the time the instant invention was made.

The invention claimed in the instant patent application was owned by Rigel, Inc. ("Rigel") or subject to an obligation of assignment to Rigel at the time the instant invention was made, as evidenced by an assignment to Rigel executed by the inventor and recorded on August 23, 2001 (Reel/Frame 012115/0311).

¹ 35 U.S.C. 103(a) : A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

² 35 U.S.C. 103(c): Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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The Nolan patent was owned by Rigel or subject to an obligation of assignment to Rigel at the time the instant invention was made, as evidenced by an assignment to Rigel executed by the inventor and recorded on October 14, 1997 (Reel/Frame 8875/0682).

Thus, the Nolan patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Rigel. Accordingly, the Nolan patent cannot preclude patentability of the instant claims under 103(a).

In view of the disqualification of Nolan patent as a prior art reference, this rejection of claims 59-61 and 63-65 under 35 U.S.C. § 103(a) may be withdrawn.

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Summary

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number RIGL-022.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: June 29, 2005By: 

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